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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/803,066      | 03/08/2001  | Paul Dubelsten       | 2151-57066          | 7212             |

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KLARQUIST SPARKMAN CAMPBELL  
LEIGH & WHINSTON, LLP  
Suite 1600  
One World Trade Center  
Portland, OR 97204

EXAMINER

MACKEY, JAMES P

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1722

DATE MAILED: 01/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/803,066             | DUBELSTEN ET AL.    |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | James Mackey           | 1722                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25,32-45 and 73-77 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25,32-45,73 and 74 is/are rejected.
- 7) ☒ Claim(s) 75-77 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
     a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input type="checkbox"/> Other: _____                                    |

1. Applicant's election with traverse of Group I, apparatus claims 1-25, 32-46 and 73-77, in Paper No. 5 is acknowledged. The traversal is on the ground(s) that there would be no undue burden on the Examiner to examine both sets of claims. This is not found persuasive because there is no reason to believe that the searches for the two distinct inventions would be co-extensive; moreover, the issues arising in the examination of process claims are diverse from the issues arising in the examination of apparatus claims. Therefore, based on the additional work involved in the search and examination of the two distinct inventions, there is an undue burden on the Examiner to examine both sets of claims together. Moreover, the traversal appears moot in view of the cancellation of the method claims 47-65.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 75-77 are objected to because of the following informalities: claims 75-77 depend from cancelled method claims; therefore, the scope of the claims cannot be determined and the claims cannot be examined. Appropriate correction is required.

3. Claims 13-15, 19, 23-25 and 43 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claims 13-15, 23-25 and 43 only recite limitations regarding the manner in which the claimed apparatus structure is intended to be operated; such relates only to the intended use of the claimed apparatus, which does not patentably distinguish the claimed apparatus and therefore does not further limit the structure of the apparatus claims. Note that intended use has been continuously held not to be germane to determining the patentability of the apparatus, In re

Finsterwalder, 168 USPQ 530; the manner or method in which a machine is to be utilized is not germane to the issue of patentability of the machine itself, In re Casey, 152 USPQ 235.

Claim 19 does not further limit the subject matter of claim 18, since claim 18 already requires plural "pairs" of gas cells.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 34, 37, 38, 42 and 44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 34, it is unclear whether the "densifying apparatus" is the same as the one recited in claim 32 or an additional densifying apparatus.

In claim 37, "densifying cells" lacks proper antecedent basis in the claim.

In claims 38 and 42, it is unclear as to how the "densifying cells" (claim 38) or "press cells" (claim 42) relate to the densifying apparatus of claim 32.

In claim 44, "the consolidation zone" lacks proper antecedent basis in the claim.

6. Applicant is advised that should claim 34 be found allowable, claim 44 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 2, 4, 8-15 and 18-25 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Tilby (U.S. Patent 5,284,546). Note that the fans 86 inherently provide a suction in the receiving cells.

9. Claims 1, 3 and 13-17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Schedin et al. (U.S. Patent 5,711,972; Figure 5).

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 5-7, 18-25, 32-44, 73 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tilby (U.S. Patent 5,284,546).

Tilby teaches the system substantially as claimed, except for a mixer in the upstream mat-forming means, and except for surface modification means. However, mat-forming apparatus having a cyclone mixer for mixing of feed materials prior to forming of the mat are well known and conventional in the mat forming art, and it would have been obvious to a skilled artisan at the time of the invention to modify Tilby by providing the mat-forming means with a cyclone mixer, as is known in the art, in order to adequately mix the feed materials and thereby assure uniformity in the formed mat. With regard to the surface modification means, such are well known and conventional in the art for preparing a surface to be coated, and it would have been obvious to a skilled artisan to modify Tilby by providing such conventional surface modification means in order to improve coating adhesion to a surface of the formed mat.

14. Claims 3, 16, 17 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tilby (U.S. Patent 5,284,546) in view of Schedin et al. (U.S. Patent 5,711,972; Figure 5).

Tilby teaches the system substantially as claimed, except for the gas cells being rollers, and except for a mixer in the upstream mat-forming means. Schedin et al. teach the use of gas roller cells for providing a heated fluid to a mat being consolidated. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Tilby by providing the gas cells as paired gas cell rollers, as disclosed in Schedin et al., since such were equivalent means for providing a heated fluid to the material being consolidated. Moreover, mat-forming

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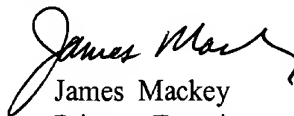
apparatus having a cyclone mixer for mixing of feed materials prior to forming of the mat are well known and conventional in the mat forming art, and it would have been obvious to a skilled artisan at the time of the invention to modify Tilby by providing the mat-forming means with a cyclone mixer, as is known in the art, in order to adequately mix the feed materials and thereby assure uniformity in the formed mat.

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Mackey whose telephone number is 571-272-1135. The examiner can normally be reached on M-F, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-0987.



James Mackey  
Primary Examiner  
Art Unit 1722

12/29/03

jpm  
December 29, 2003